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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,336	02/18/2000	Scott C. Anderson	003-005-CP	7956

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HOEKENDIJK & LYNCH, LLP
P.O. BOX 4787
BURLINGAME, CA 94011-4787

EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3735

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,336

Applicant(s)

ANDERSON ET AL.

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 12, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-38, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-38, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant argues that Rittman, III et al does not anticipate the claims due to the lack of recitation of a surface. The examiner must respectfully disagree. Rittman, III et al create a surface surrounding the probe on insertion thereof. Thus a surface as claimed is clearly present in the method of Rittman, III et al. Applicant continues arguing that a near and far surface is required. However, as there is no particular requirement of the two surfaces tother than that they be "near" and "far" relative to each other, it is clear that a point on the surface created by the insertion of the probe in Rittman, III et al which is to some degree distant or "far" from the point of ablative contact constitutes a "far surface" as recited in the claims. With regard to the measurement of temperature to provide tissue characterization, applicant argues the disclosure, rather than the limitations present in the claims. However as the rejection has been applied to the claims, this is not convincing. There is no exclusion in the claims which would prevent the temperature measurement to be used to characterize the tissue as "sufficiently ablated" for example, wherein the ablation would continue, in response to the characterization of the tissue being "insufficiently ablated". Since the tissue is measured as the temperature changes, the steps of changing the temperature with the ablating element and ablating with the ablating element are fulfilled by the method of Rittman, III et al. In other words, as applicant has disclosed no particular duration of either of the steps argued, nor any particular interval that must exist between the cessation of one step and the commencement of the next, the step of measuring the temperature during one moment of ablation determines the treatment parameters (e.g. whether or not to continue ablating) during the step of the next moment of ablation. Thus applicant's

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arguments with respect to the occurrence of various steps of Rittman, III et al during the ablation process do not serve to distinguish the claims over Rittman, III et al.

With regard to the Swanson et al, applicant argues that the Swanson et al reference does not provide the tissue characterization step claimed. While the examiner notes that Swanson et al do provide for tissue characterization (the mapping of Swanson et al), this is immaterial, as the tissue determination is taught by Rittman, III et al, as set forth above. Further with regard to the combination of Swanson et al and Rittman, III et al, applicant argues that Rittman, III et al teach the use of a cooled tip electrode, one that is discussed by Swanson as having possibly hazardous implications for cardiac ablation. The examiner notes that the teachings of the prior art are to be evaluated by one having ordinary skill in the art. As such, it is clear that the use of the temperature detection of Rittman, III et al, would mitigate any possibility of damage from sub surface temperatures becoming too high, the sole disadvantage of the cool tip method according to Swanson. Still further, applicant argues that “the plain words of Swanson et al would discourage one of ordinary skill from pursuing Swanson as a device for epicardial ablation”, asserting that Swanson et al teach away from such a method, and citing *In re Gurley*. The examiner respectfully notes section IV of Swanson et al, entitled “Epicardial Applications of Probe-type apparatus” in view of this, it is unclear how applicant can assert that Swanson et al teach away from epicardial applications of the device. Further still applicant argues that “selective combination” requires a motivation other than hindsight. However, since the examiner has applied motivation gleaned from the references themselves, applicant’s reliance on *Interconnect Planning* is misplaced. Applicants arguments regarding the combination including

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Ben Haim rely on the deficiency of the combination already argued. However, as the combination is not deficient, as set forth above, this argument is not convincing.

With regard to the double patenting rejections, applicant argues that the instant claims all recite tissue characterization, the examiner respectfully notes that both the 6,645,202 and the 6,805,129 patents claim the use of ultrasound transducers, these are disclosed as including the function of temperature feedback at column 7, lines 23-32, in both patents, thus this argument is not convincing. The obviousness double patenting rejection with respect to 6,971,394 has been withdrawn.

Claims 34-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rittman, III et al in combination with Swanson et al. Rittman, III et al teaches a method such as claimed except epicardial placement and activation of no more than half the ablating elements. Swanson et al teaches the desirability of ablating on the epicardium and that less than half the total number of electrodes can be used. It would have been obvious to, the artisan of ordinary skill to employ the method of Swanson et al in the method of Rittman, III et al, since the method of Swanson et al is applicable to both intravascular and extravascular treatments, thus producing a method such as claimed.

Claim 41 is rejected under 35 UCS.C. 103(a) as being unpatentable over Rittman, III et al in combination with Swanson et al as applied to claims 34-38 and 40 above, and further in view of Ben Hain et al. Ben Hain teaches drawing tissue into a suction well prior to ablation. It would have been obvious to employ the step of drawing the tissue desired to be ablated into suction surrounding the ablating elements since this allows the catheter to remain stable while the tissue is ablated, thus producing a method such as claimed.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34-38, 40, and 41 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 10 of U.S. Patent No. 6,805,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent application claims. Here, the patent application claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 34-38, 40, and 41 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19, 20, 24, 25, 34, 35, 39, 40, 50, and 51 of U.S. Patent No. 6,645,202. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the

application. Accordingly, instant application claims are not patentably distinct from the patent application claims. Here, the patent application claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Applicant's arguments filed July 12, 2006 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

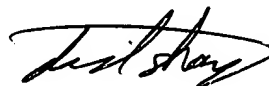
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330